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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,492	02/27/2002	David Farcot	P21987	8439

7055 7590 07/19/2002

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/083,492	Applicant(s) FARCOT ET AL.	
	Examiner Christopher Bottorff	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/990,308.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/990,308, filed on November 23, 2001.

Information Disclosure Statement

The examiner has considered the information disclosure statement submitted on May 28, 2002.

Specification

The disclosure is objected to because of the following informalities: Figure 1 does not have line IV-IV, as indicated in paragraph 0017 on page 4. However, Figure 1 does have line III-III. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the limitation "the oblong holes" in line 7. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, "the oblong holes" have been interpreted as referring to the elongated holes previously referred to in the claim.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5 are ^{provisionally} rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of prior ^{co-pending application} U.S. Patent No. 09/990,308. This is a ^{provisional} double patenting rejection. ^{Since the conflicting claims have not in fact been patented.}

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. US 5,909,893 in view of Tanaka US 6,386,574.

Keller et al. discloses an assembly for retaining a boot on a sports apparatus. See figure 3; column 2, lines 44-50; and column 4, lines 6-29. The assembly has a disk 1 that retains a base, wherein the disk includes four elongated holes 10 that extend through the disk in its thickness, are parallel to one another, are aligned in pairs, and are across from one another. Also, two rectangular plates 12 that are parallel to the disk are house in a cavity 11 of the disk, wherein the cavity has a parallelepipedic contour. Each plate includes two holes 13 extending through the plate in its thickness and each plate slides along the length of the elongated holes. Screws 8 extend through the elongated holes of the disk and the holes of each plate.

While Keller et al. suggests that the disk is retained in a base, a base is not explicitly disclosed. In addition, the plate is not square with four holes spread to the four corners of the square and is not located on the lower portion of the disk.

However, Tanaka teaches that the practice of providing a disk 72 in a base 14 of a boot-retaining apparatus was old and well known in the art at the time the invention was made. See figure 1 and column 2, lines 44-45. From the teaching of Tanaka, providing the assembly of Keller et al. with a base would have been obvious to one of ordinary skill in the art at the time the invention was made. Such a modification would allow the assembly to receive the sole of a boot.

In regard to the square shape of the plate, in paragraph 0043 on page 8 of the specification Applicants state that the shape of the plate is not a critical feature.

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Applicants are reminded that the criticality of a feature must be established before that feature can be relied upon as evidence of unobviousness. Compare *In re Fields*, 134 USPQ 242 (CCPA, 1962); *In re Russell*, 169 USPQ 426 (CCPA, 1971). Providing the plate of Keller et al. as a square with holes at the corners, rather than two rectangles with holes at the ends, represents an obvious design choice that was within the purview of one of ordinary skill in the art at the time the invention was made. This modification would reduce the number of parts in the assembly.

Furthermore, arranging the plate on the lower portion of the disk, rather than in a cavity of the disk, represents an obvious reversal of parts. It is well settled that merely reversing the parts of an apparatus is an obvious expedient. See *In re Gazda*, 104USPQ 400 (CCPA 1955).

Conclusion

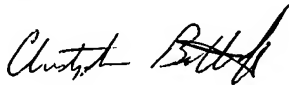
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stevens, Carenter et al. US 5,261,689, Carpenter et al. US 5,356,170, Metzger et al., Erb, Perlman, Bayer et al., Beran, Lee, and Tanaka US 6,206,402 disclose boot-retaining assemblies. Note that Perlman US 5,791,678 teaches a square plate retained in a cavity of a disk.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff
July 13, 2002



BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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